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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/434,779	05/04/95	SIEVERT	D 3616.85US02

35M1/0425
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KENT, C		EXAMINER
ART UNIT	PAPER NUMBER	
3504	6	

DATE MAILED:
04/25/96

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.

08/434,779

Applicant(s)

Dick J. Sievert et al.

Examiner

Christopher Kent

Group Art Unit

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☒ Responsive to communication(s) filed on Jan 25, 1996

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 17-49 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 17-41 and 43-49 is/are rejected.

☒ Claim(s) 42 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on May 4, 1995 is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on Jan 25, 1995 is ☐ approved ☒ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

C. Kent

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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The following office action is in response to patent examination application serial number 08/434,779, filed on 05/04/95.

Acknowledgement is made of the receipt of the response filed 01/25/96. Claims 1-11 and 16 have been cancelled. Claims 17-49 remain pending on the merits. New Figures 3A and 6A are proposed.

OBJECTION TO THE DRAWINGS

The drawings are objected to under 37 C.F.R. § 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, a block having an "outwardly curving surface" as in claims 23 and 35 must be shown; and a block having "a first and a second protrusion" must be shown, or the feature cancelled from the claim. No new matter should be entered.

OBJECTION TO THE DISCLOSURE

The disclosure is objected to because of the following informalities: on pages 5 and 34, serial number 07/828,031 should be updated to reflect its current status as U.S. Patent Number 5,249,950; and there exists no brief description of proposed Figures 3A and 6A. Appropriate correction is required.

REJECTION - 35 U.S.C. 112, SECOND PARAGRAPH

Claims 28, 29, 38, 39, 48 and 49 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 28, 29, 38 and 39 appear to be contradictory to the claims from which they ultimately depend, claim 17 and 30. Claims 17 and 30 recite a block having "a protrusion", and claims 28, 29, 38 and 39 recite a block having "a first and a second protrusion". In claim 48, "claims" appears to be a typo of "claim". And claims 48 and 49 are unclear and confusing since they recite a structure comprising a single block as described in claims 17 and 30, respectively. They should, perhaps, recite a "plurality of the blocks of claim ...".

OBVIOUSNESS DOUBLE PATENTING

Claims 17, 18, 21-27, 30, 31, 33-41 and 43-49, as understood, are considered to be rejectable over the claimed disclosure of application serial number 08/322,357, which was issued a notice of allowability on 08/23/95, on the basis of judicially created non-statutory double patenting [see In re Schneller, 397 F.2d 350;158 USPQ 210 (CCPA 1968)]. A perusal of

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the instant claims clearly indicates that the subject matter thereof is fully disclosed by the claims of said patent and/or that portion of the patent disclosure which provides support for such claims [see In re Vogel, 422 F.2d 438; 164 USPQ 619 (CCPA 1970)]. Therefore, it is axiomatic that the instant claims are nothing more than obvious variations of the inventions disclosed and claimed in said patent and cannot properly issue in the absence of a terminal disclaimer. Furthermore, it is also clear that the inventor could have included the instant claims in said patent and that if the instant application were to issue without a terminal disclaimer, protection of the previously patented inventions would be improperly extended until the expiration of the instant claims since the utilization of such inventions would infringe the instant claims.

Claim 20 is considered to be provisionally rejectable over the claimed disclosure of application serial number 08/447,757, which is copending, on the basis of judicially created non-statutory double patenting [see In re Schneller, 397 F.2d 350; 158 USPQ 210 (CCPA 1968)]. A perusal of the instant claims clearly indicates that the subject matter thereof is fully disclosed by the claims of said patent and/or that portion of the patent disclosure which provides support for such claims [see In re Vogel, 422 F.2d 438; 164 USPQ 619 (CCPA 1970)]. Therefore, it is

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axiomatic that the instant claims are nothing more than obvious variations of the inventions disclosed and claimed in said patent and cannot properly issue in the absence of a terminal disclaimer. Furthermore, it is also clear that the inventor could have included the instant claims in said patent and that if the instant application were to issue without a terminal disclaimer, protection of the previously patented inventions would be improperly extended until the expiration of the instant claims since the utilization of such inventions would infringe the instant claims.

Claims 19, 32 and 40 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claimed disclosure of application serial number 08/322,357 in view of Habegger. Application serial number 08/322,357 lacks protrusion sides of the different prescribed angles. This limitation is viewed as an obvious and known choice of design as shown in Habegger Fig. 15. The specific angles of claim 11 are considered design choices in absence of a basis for the selection of the specific choices made.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37

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C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

RESPONSE TO REMARKS

Applicant's arguments filed 01/25/96 have been fully considered but they are not deemed to be persuasive.

Objection to the Drawings - The disclosure as originally filed does not support the detail shown in proposed Figures 3A and 6A. The protrusions are described on page 8 as "... may also comprise one or more protrusions 26. Each protrusion is preferably positioned adjacent an inset 22A or 22B, on the block top surface 10." There is no mention of the shape of the protrusions, shown in the proposed figures as round, having a smaller top surface than base, etc...". Therefore the proposed **Figures 3A and 6A are not accepted**. Figures 4 and 6 show blocks having faceted front faces as described on pages 9 and 10 "comprise a split or faceted front surface having three sides, Figs. 4-6." Therefore the objection to the drawings stands as set forth in the previous office action.

Objection to the Disclosure - No brief description of proposed

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Figures 3A and 6A were presented. The status of 07/828,031 should be updated in the specification.

Rejections - 35 U.S.C. 112, Second Paragraph - Claims 28, 29, 38 and 39 still appear to contradict claims 17 and 30 from which they depend. The rejection of claim 48 under this statute was not addressed and no amendment to rectify was made. The further rejections of claim 48 and 49 are new and explained in the rejection.


Rejections - Obviousness Double Patenting - The rejection under Obvious-type double patenting stands as modified above to reflect the cancellation of claims 1-11 and 16. Applicant has failed to traverse the rejections against the copending applications and has failed to provide a rationale which states why it would not have been obvious to provide the protrusions with angled surfaces as suggested by Habegger. Applicant argues only the rationale for his provision of the protrusions having angled surfaces and that the copending applications do not suggest this provision. The rejection states that Habegger suggests the protrusions having angle surfaces.

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Any inquiry concerning this communication should be directed to Christopher Kent at (703) 308-2497.



Christopher T. Kent
April 12, 1996

CHRISTOPHER T. KENT
PATENT EXAMINER
GROUP 3504